

REMARKS

A. Status of the Claims

Claims 1-4, 8-10, 12, 13, 15-20, 22, 23, 40-51, 54, 55, 61, 66-68, 70-72, and 84-86 were examined prior to issuance of the last Office Action. All were rejected. Claim 8 has been canceled without prejudice to prosecuting it at a later time in this or a continuing application. Thus, upon entry of the requested amendments, claims 1-4, 9, 10, 12, 13, 15-20, 22, 23, 40-51, 54, 55, 61, 66-68, 70-72, and 84-86 will be pending.

B. Claims 8, 9, 61, 66 and 84-86 Are Patentable over the 257 Application

The Office rejects claims 8, 9, 61, 66 and 84-86 as being anticipated by the British 257 Application. Claim 8 has been canceled. As to the remaining claims, Applicant respectfully traverses.

1. Independent Claim 9

Independent claim 9 is directed to a system useful in stabilizing a vessel. The vessel includes a first leg, a second leg, a third leg, and a platform coupled to the first, second, and third legs such that the platform may be raised or lowered along the first, second and third legs. The system comprises a first brace that is coupled to the first leg at a first location along the first brace. The first brace forms an acute angle with the first leg. The system also includes an anchoring structure that is coupled to the first brace at a second location along the first brace. The first and second locations along the first brace define a first brace length between them. At least a portion of the first brace length is located directly beneath the platform. One or more racks are secured to the first leg, and the anchoring structure includes a ring coupled to the platform, the ring having a holding rack configured to engage one of the one or more racks.

As explained in the last response, the 257 Application does not disclose an anchoring structure to which a first brace is coupled that includes a ring having a holding rack configured to engage one of one or more racks secured to a leg. The Office does not and cannot point to the claimed ring. Instead, the Office states “the legs have racks (see Fig. 1) and the holding rack (5) configured to engage one of the one or more racks (see US Patent 4270877 for such notoriously old and conventional rack and rack holding means).” Action at page 2; *see also* Action at page 8.¹ The Office is arguing that the ’877 patent shows that the lower part 5 of the climbing and locking mechanism of the 257 Application **necessarily** has the claimed ring. The Office has not carried its burden.

As the Board explained in *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990), “[i]n relying on inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis in original). The mere possibility that the technology shown in the ’877 patent—assuming it shows the claimed ring, which Applicant does not concede—“does not legally suffice to show anticipation.” *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1306 (Fed. Cir. 1999). “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Office simply points to the ’877 patent and asserts, without

¹ On page 8 of the Action, the Office mischaracterizes Applicant’s prior arguments. Applicant has not argued that the 257 Application fails to disclose a “rack secured to the legs and a holding rack engaging said legs[.]” Instead, Applicant has argued that, with respect to claim 9, “[t]he 257 Application simply does not disclose an anchoring structure to which a first brace is coupled that includes a **ring** having a holding rack configured to engage one or more racks secured to a leg” (see page 17 of last response; emphasis added), and, with respect to claim 61, “[t]he 257 Application simply does not disclose coupling a brace to an anchoring structure that includes a **ring** having a holding rack configured to engage one or more racks secured to a leg” (see page 21 of last response; emphasis added).

evidence or reasoning, that it discloses the technology used in the 257 Application. The Office's assertion is insufficient to establish inherency. *Ex parte Levy*, 17 USPQ2d at 1464 (reversing rejection because examiner did not provide "sufficient factual basis or cogent scientific reasoning" to support conclusion of inherency). Moreover, according to the inventor, the '877 patent does not show the claimed technology. *See Declaration of Masasuke Kawasaki* at ¶ 4. The rejection should therefore be withdrawn.

2. Independent Claim 61

Independent claim 61 is directed to a method useful in stabilizing a vessel. The vessel has a platform, three or more legs coupled to the platform such that the platform may be raised or lowered along the legs, and one or more racks secured to one of the legs. The method includes coupling a first brace to one of the legs and an anchoring structure such that at least a portion of the first brace is positioned directly beneath the platform and the first brace is oriented at an acute angle with the leg to which it is coupled. The anchoring structure includes a ring coupled to the platform, the ring has a holding rack configured to engage one of the one or more racks, and the first brace is coupled to the ring.

The 257 Application does not disclose an anchoring structure to which a first brace is coupled that includes a ring coupled to the platform, the ring having a holding rack configured to engage one of the one or more claimed racks, and the first brace being coupled to the ring. The Office does not and cannot point to the claimed ring. Instead, the Office states "the legs have racks (see Fig. 1) and the holding rack (5) configured to engage one of the one or more racks (see US Patent 4270877 for such notoriously old and conventional rack and rack holding means)." Action at page 2; *see also* Action at page 8. The Office is arguing that the '877 patent shows that

the lower part 5 of the climbing and locking mechanism of the 257 Application **necessarily** has the claimed ring. The Office has not carried its burden.

As the Board explained in *Ex parte Levy*, 17 USPQ2d at 1464, “[i]n relying on inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (emphasis in original). The mere possibility that the technology shown in the ’877 patent—assuming it shows the claimed ring, which Applicant does not concede—“does not legally suffice to show anticipation.” *MEHL/Biophile Int’l Corp. v. Milgraum*, 192 F.3d at 1365, 52 USPQ2d at 1306. “Inherency . . . may not be established by probabilities or possibilities. The mere fact that a thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d at 745, 49 USPQ2d at 1950-51. The Office simply points to the ’877 patent and asserts, without evidence or reasoning, that it discloses the technology used in the 257 Application. The Office’s assertion is insufficient to establish inherency. *Ex parte Levy*, 17 USPQ2d at 1464 (reversing rejection because examiner did not provide “sufficient factual basis or cogent scientific reasoning” to support conclusion of inherency). Moreover, according to the inventor, the ’877 patent does not show the claimed technology. *See* Declaration of Masasuke Kawasaki at ¶ 4. The rejection should therefore be withdrawn.

3. Independent Claim 66

Independent claim 66 is directed to a method useful in stabilizing a vessel. The vessel has a platform, three or more legs coupled to the platform such that the platform may be raised or lowered along the legs. The method includes coupling a first brace to one of the legs; orienting the first brace at an acute angle with the leg to which it is coupled; positioning at least a portion

of the first brace directly beneath the platform; and lifting a leg that horizontally shifts in order to restore an earlier position of the leg.

As pointed out in the last response, the 257 Application does not disclose lifting a leg that horizontally shifts, as claimed. The Office does not address this in its March 2005 Action, and has failed to carry its burden of making a proper anticipation rejection. *See* MPEP § 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”); MPEP § 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”). The Board has reversed rejections where the Office fails to address a limitation in a claim. *See In re Bell*, Appeal No. 97-0126 at pages 6-7 (not binding precedent; copy enclosed).

The 257 Application discusses the fact that the columns of the pontoon are independently movable. *See, e.g.*, page 1, lines 78-79 and page 2, lines 101-103 (claim 1). However, nothing in the 257 Application discloses or suggests lifting a leg that has shifted horizontally. Thus, claim 66 is not anticipated by the 257 Application, and the rejection should be withdrawn.

4. Independent Claim 84

Claim 84 is directed to a vessel. The vessel includes a platform; three legs coupled to the platform such that the platform may be raised or lowered along the three legs; a footing structure coupled to an end of one of the legs; and a flexible brace coupled at two different locations to the leg with the footing structure. The flexible brace forms an acute angle with that leg. One of the two claimed locations is on the footing structure.

As pointed out in the last response, the 257 Application does not disclose any legs that have a footing structure coupled to them, and, moreover, does not disclose coupling a brace at **two different locations** to a leg with a footing structure, where one of those locations is **on the footing structure**. The Office does not address this in its March 2005 Action, and has failed to carry its burden of making a proper anticipation rejection. *See* MPEP § 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”); MPEP § 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”). The Board has reversed rejections where the Office fails to address a limitation in a claim. *See In re Bell*, Appeal No. 97-0126 at pages 6-7.

Accordingly, Applicant respectfully requests that this anticipation rejection be withdrawn.

5. Independent Claim 85

Claim 85 is directed to a system useful in stabilizing a vessel. The vessel includes a first leg, a second leg, a third leg, and a platform coupled to the first, second, and third legs such that the platform may be raised or lowered along the first, second and third legs. The system comprises a brace coupled to each leg such that each brace forms an acute angle with the leg to which it is coupled and a least a portion of each brace is located directly beneath the platform; and an anchoring structure coupled to each brace. Claim 85 has been amended to clarify that each anchoring structure is configured to tension the brace to which it is coupled such that each brace can be tensioned independently of the other braces.

As explained in the last response, the 257 Application completely fails to address the issue of tensioning its lines and chains independently; they are always tensioned together by raising the platform “a little bit upwardly” or “a little bit downwardly.” *See* page 1, lines 105-111 and claim 8. Furthermore, for the reasons provided below with respect to claims 1 and 40, the reversing wheel 22 and connection point 24 (which could be occupied by a clamp) of the 257 Application are not capable of tensioning any lines. They may be capable of maintaining tension imparted to the lines by lowering the platform/pontoon, but they cannot performing the tensioning themselves, as required by the claimed anchoring structures. The Office does not explain the basis for its rejection of this claim in the last Action, and has not carried its burden of establishing a proper anticipation rejection. *See* MPEP § 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”); MPEP § 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”); *In re Bell*, Appeal No. 97-0126 at pages 6-7.

6. Independent Claim 86

Claim 86 is directed to a method useful in stabilizing a vessel. The vessel has a platform and three or more legs coupled to the platform such that platform may be raised or lowered along the legs. The method comprises coupling a brace to each leg such that each brace forms an acute angle with the leg to which it is coupled and a least a portion of each brace is located directly beneath the platform. This claims has been amended to clarify that the method also includes

coupling each brace to an anchoring structure that is configured to tension the brace to which it is coupled such that each brace can be tensioned independently of the other braces.

As explained in the last response, the 257 Application completely fails to address the issue of tensioning its lines and chains independently; they are always tensioned together by raising the platform “a little bit upwardly” or “a little bit downwardly.” *See* page 1, lines 105-111 and claim 8. The Office does not explain the basis for its rejection of this claim in the last Action, and has not carried its burden of establishing a proper anticipation rejection. *See* MPEP § 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be ‘rejected’ and the ground of rejection fully and clearly stated A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.”); MPEP § 707.07(f) (“Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it.”); *In re Bell*, Appeal No. 97-0126 at pages 6-7.

C. Claims 1, 2, 12, 13, 15-20, 22 and 23 Are Patentable over the Asserted Combinations

The Office rejects claims 1, 2, 12, 13, 15-20, 22 and 23 as being obvious over the 257 Application in view of Vincken (USPN 3,681,928), Petty 710 (USPN 4,936,710), Petty 239 (USPN 4,293,239) or Roach (USPN 4,378,178). Applicant respectfully traverses.

Claim 1 is directed to a system useful in stabilizing a vessel. The vessel includes a first leg, a second leg, a third leg, and a platform coupled to the first, second, and third legs such that the platform may be raised or lowered along the first, second and third legs using pinions driven by one or more motors. The system comprises a first brace coupled to the first leg at a first location along the first brace, the first brace forming an acute angle with the first leg. The first brace is coupled at a second location along the first brace to a winch driven by a winch motor

capable of tensioning the first brace. The first and second locations along the first brace define a first brace length between them. At least a portion of the first brace length is located directly beneath the platform, and the winch motor is synchronized with the one or more motors such that tension in the first brace is maintained with the winch while raising or lowering the platform. The underlined portions have been added to further distinguish the 257 Application, and for no other reason.

The Office admits that the 257 Application fails to disclose coupling one of its braces to a winch driven by a winch motor capable of tensioning the first brace. Nonetheless, the Office asserts that Vincken, Petty 710, Petty 239 and Roach each disclose “means for tensioning a brace which includes a winch driven by a winch motor” and that:

It would have been considered obvious to one of ordinary skill in the art to modify British document ‘257 by substituting the tensioning means as taught by [one of the four references] for the tensioning means disclosed by British document ‘257 (see British document page 2 line 40 and members 22,24) since it would be an obvious design choice. It should be noted that it is well established in the art to tension a member one can use a winch that is motor actuated.

Action at page 4.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)) (emphasis in MPEP). Claim 1 has been amended to recite that the winch motor is synchronized with the one or more motors such that tension in the first brace is maintained with the winch while raising or lowering the platform. The 257 Application teaches away from this.

The “special tensioning mechanism” recited at page 2, line 40 of the 257 Application does **not**—as the Office incorrectly asserts—pertain to reversing wheel 22 or clamp 24, which

are discussed at lines 48-53 of page 2. Instead, the “special tensioning mechanism” pertains to the chain stopper technology discussed in lines 25-38 of page 2.

The purpose of reversing wheel 22 is to direct the force acting on pontoon 1 at connection point 24 resulting from the tension in cable 20 to a direction **opposite** the force of the pontoon’s weight:

Whereas tensioning of the c[h]ains 8 and 9 with the first embodiment has a result that the locking members in part 5 are additionally loaded, the embodiment with cables which extend over reversing discs at the upper end of the columns will perform the reverse because the tension force in said cables 20 at the location of the connection 24 is directed opposite to the force of gravity of the pontoon.

257 Application at page 2, lines 54-62. In contrast to the additional load on the locking members in part 5 that occurs using chain stoppers 12 , off-loading the tension in cable 20 to connection point 24 results in **lowering the holding force** required at part 5. Thus, the 257 Application teaches away from loading reversing wheel 22 or using it to tension the lines. *See also* page 1, lines 97-111 (describing unloading the locking members (*i.e.*, the reversing wheels) and tensioning such lines by moving the platform “a little bit downwardly”).

There is no motivation to replace reversing wheel 22 with a winch that is configured to maintain tension in cable 20. If such a substitution were made, and the claimed configuration of the winch were utilized such that the winch remained loaded (as opposed to unloading the force to a clamp at connection point 24), the 257 Application’s stated purpose of taking load off the locking members in part 5 will not be realized. *See* Kawasaki Decl. at ¶ 5. Furthermore, there is no motivation to synchronize a winch motor with one or more pinion-driving motors based on any of the cited references. *Id.* at ¶8.

For these reasons, the rejection of claim 1 has been overcome, and should be withdrawn. The claims that depend from claim 1 are patentable for at least these same reasons.

D. Claim 3 Is Patentable over the Asserted Combination of the 275 Application and McGehee

The Office rejects claim 3 as being obvious over the 257 Application in view of Vincken, Petty 710, Petty 239 or Roach and further in view of McGehee (USPN 4,813,815). Applicant respectfully traverses. Claim 3 is patentable for the same reasons as claim 1. McGehee does not cure the deficiencies of the previously-traversed combination. Therefore, the rejection should be withdrawn. Applicant does not acquiesce to the Office's asserted motivation for combining McGehee with the other cited references.

E. Claims 10 and 67-68 Are Patentable over the Asserted Combination of the 275 Application and Kutchai

The Office rejects claims 10 and 67-68 as being obvious over the 257 Application in view of Kutchai (USPN 3,850,397). Applicant respectfully traverses.

1. Independent Claim 10

Independent claim 10 is directed to a system useful in stabilizing a vessel. The vessel includes a first leg, a second leg, a third leg, and a platform coupled to the first, second, and third legs such that the platform may be raised or lowered along the first, second and third legs. The system comprises a rigid first brace that is coupled to the first leg at a first location along the rigid first brace. The rigid first brace forms an acute angle with the first leg. The system also includes an anchoring structure that is coupled to the rigid first brace at a second location along the rigid first brace. The first and second locations along the rigid first brace define a first brace length between them. At least a portion of the first brace length is located directly beneath the platform.

The Office admits that the 257 Application fails to teach or suggest a rigid first brace. Nevertheless, the Office asserts that it would have been obvious to "modify the British document

by substituting the bracing means as taught by Kutchai for the bracing means disclosed by the British document since such a modification is a mere design choice. Depending on what load one is interested in resisting namely tension or compression, such parameter would dictate whether to use a flexible or rigid brace.” Action at page 5.

There is no way to use a rigid brace with the device disclosed in the 257 Application without changing the principle of operation of the 257 Application device. *See* Kawasaki Decl. at ¶ 6. All the lines/chains disclosed in the 257 Application are flexible, and must be flexible in order to achieve the “tension resistant connections” described and shown in the 257 Application. The chain stopper connection of chains 8 and 9, and the cable clamp connection of line 20 each require flexibility, and simply would not work with the rigid structure disclosed in Kutchai. Furthermore, while the 257 Application discloses connecting line 25 directly to another column at point 26, it specifies in both cases where that connection is discussed that line 25 is **also** capable of being extended upwards and connected **above deck** (at 27 in FIG. 1), which requires flexibility. Thus, all the connections disclosed and shown require flexibility. The rejection should be withdrawn. *See In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

2. Independent Claim 67

Independent claim 67 is directed to a method useful in stabilizing a vessel. The vessel includes a platform and three or more legs coupled to the platform such that the platform may be raised or lowered along the legs. The method includes coupling a first brace to one of the legs; orienting the first brace at an acute angle with the leg to which it is coupled; and positioning at least a portion of the first brace directly beneath the platform. The first brace is rigid.

Claim 67 is patentable for the same reasons as claim 10. Therefore, the rejection of claim 67 and dependent claim 68 should be withdrawn.

F. Claims 40, 41 and 43-51 Are Patentable over the Asserted Combination of the 275 Application and Wolff

The Office rejects claims 40, 41 and 43-51 as being obvious over the 257 Application in view of Wolff (USPN 5,390,618). Applicant respectfully traverses.

Claim 40 is directed to a vessel. The vessel includes a platform; three legs coupled to the platform such that the platform may be raised or lowered along the three legs; a flexible brace coupled to each of the three legs at a first location along each flexible brace, each flexible brace forming an acute angle with its respective leg; and an anchoring structure coupled to each flexible brace at a second location along each flexible brace, the first and second locations along each flexible brace defining a flexible brace length between them. At least one anchoring structure is capable of achieving 40,000 pounds of tension in the flexible brace to which it is coupled.

The Office admits that the 257 Application fails to disclose the claimed an anchoring structure, but points to a winch in Wolff capable of achieving the claimed tensile force and asserts that use of such a winch “would be an obvious design choice. It should be noted that depending on what amount of load one is interested in resisting, then the tensioning means would be chosen accordingly.” Action at pages 5-6. This rejection is based on hindsight.

The 257 Application discloses no dimensions of any kind about any of the components of the jack up islands it concerns. Wolff is concerned with mooring vessels, not with tensioning braces connected to the legs of jack-up boats. Of course anchoring structures, such as winches, possessing the claimed capability exist. However, the Office cites no evidence that shows that

those of ordinary skill in the art aware of the 257 Application would have recognized the need for such an anchoring structure, especially where no sizes or loads are explained in the 257 Application. *See* Kawaski Decl. at ¶ 7; *see In re Nomiya*, 184 USPQ 607, 612-613 (CCPA 1975) (holding that it is improper to conclude that an invention is obvious absent evidence that one of ordinary skill would have recognized that an underlying problem existed). The knowledge of that need comes only from Applicant's specification (page 35).

The Office's approach is not supported by substantial evidence. As the Federal Circuit explained in *Zurko*:

With respect to **core factual findings** in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added).

The MPEP provides instruction that follows the *Zurko* decision. MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely **solely** on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697).

Accordingly, the rejection of claim 40 and its dependents should be withdrawn.

G. Claim 4 Is Patentable over the Asserted Combination

The Office rejects claim 4 as being obvious over the 257 Application in view of Vincken, Petty 710, Petty 239 or Roach and further in view of Thomas, Hansen or Hornsby. Applicant respectfully traverses. Claim 4 is patentable for the same reasons as claim 1. Neither Thomas, Hansen or Hornsby cures the deficiencies of the previously-traversed combination. Therefore,

the rejection should be withdrawn. Applicant does not acquiesce to the Office's asserted motivation for combining Thomas, Hansen or Hornsby with the other cited references.

H. Claim 42 Is Patentable over the Asserted Combination

The Office rejects claim 42 as being obvious over the 257 Application in view of Wolff and further in view of Thomas, Hansen or Hornsby. Applicant respectfully traverses. Claim 42 is patentable for the same reasons as claim 40. Neither Thomas, Hansen or Hornsby cures the deficiencies of the previously-traversed combination. Therefore, the rejection should be withdrawn. Applicant does not acquiesce to the Office's asserted motivation for combining Thomas, Hansen or Hornsby with the other cited references.

I. Claims 54, 55, 70 and 71 Are Patentable over the Asserted Combination

The Office rejects claims 54, 55, 70 and 71 as being obvious over the 257 Application in view of Vincken, Petty 710, Petty 239, Roach or Wolff and Legleux (USPN 6461081). Applicant respectfully traverses.

Claim 54 is directed to a method useful in stabilizing a vessel that has a platform and three or more legs coupled to the platform such that the platform may be raised or lowered along the legs. The method includes coupling a first brace to one of the legs; orienting the first brace at an acute angle with the leg to which it is coupled; and positioning at least a portion of the first brace directly beneath the platform. Pinions driven by one or more motors are used for the raising or lowering of the platform, and the method also includes coupling the first brace to a winch driven by a winch motor, and synchronizing the winch motor with the one or more motors such that tension in the first brace is maintained synchronizing the winch motor with the one or more motors such that tension in the first brace is maintained at the winch while raising or

lowering the platform. The underlined portion was added to further distinguish the 257 Application.

The 257 Application teaches away from replacing the reversing wheel 22 with a winch that maintains, as claimed, tension in a brace as explained above with respect to claim 1. *See* Kawasaki Decl. at ¶ 5. Furthermore, the 257 Application fails to support any motivation for adjusting tension in any of the lines/chains using anything other than platform. *See* page 1, lines 105-111. Even claim 8 on page 3 specifies “the tension members are tensioned by **moving the platform** with respect to the column after the tension members being connected and straightened.” (Emphasis added). Because of these teachings away, the rejection is overcome and should be withdrawn.

Furthermore, the Office’s statement that the claimed synchronizing would be an obvious design choice is based on hindsight. As the Board once explained in a non-precedential decision, “It is not persuasive to just make up a rationale that might fit the circumstances, as the Examiner appears to have done, because the lack of factual support smacks of hindsight.” *In re Orlofsky*, Appeal No. 2000-0377 at page 10 (not binding precedent; copy enclosed). There is no recognition in any of the cited references that such synchronization is needed. *See* Kawasaki Decl. at ¶ 8; *see In re Nomiya*, 184 USPQ 607, 612-613 (CCPA 1975) (holding that it is improper to conclude that an invention is obvious absent evidence that one of ordinary skill would have recognized that an underlying problem existed). Accordingly, the Office’s approach is not supported by substantial evidence. As the Federal Circuit explained in *Zurko*:

With respect to **core factual findings** in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

In re Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (emphasis added). The MPEP provides instruction that follows the *Zurko* decision. MPEP § 2144.03 at 2100-138 (“It is never appropriate to rely **solely** on common knowledge in the art without evidentiary support in the record as the principal evidence on which the rejection was based.”) (citing *In re Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697). For this additional reason, the rejection of claim 54 and its dependents should be withdrawn.

J. Arguments Reserved for Dependent Claims

Each of the present dependent claims is patentable over the cited art for at least the reasons that their respective independent claims are patentable. Applicants reserve the right to provide additional arguments in support of the patentability of the present dependent claims should doing so become necessary. Applicants do not acquiesce to any of the Office’s arguments or statements concerning the patentability of the present dependent claims.

K. Petition for Extension of Time

Pursuant to 37 C.F.R. § 1.136(a), Applicant petitions for an extension of time of one month up to and including August 1, 2005 (July 30, 2005 falls on a Saturday) in which to respond to the March 30, 2005 Office Action. Should the small-entity check for this extension of time be missing, or should any other fees be required, the Commissioner is authorized to deduct the appropriate fees required for any reason relating to the enclosed materials from Fulbright & Jaworski Deposit Account No.: 50-1212/DGSN:002US.

L. Conclusion

These remarks fully respond to all outstanding matters for this application. Applicant respectfully requests that the Office withdraw the current rejections and allow pending claims 1-

4, 9, 10, 12, 13, 15-20, 22, 23, 40-51, 54, 55, 61, 66-68, 70-72, and 84-86. Should the Examiner desire to discuss this application in more detail by telephone, or if any additional concerns remain, the undersigned attorney may be reached at 512-536-3031 (voice), 512-536-4598 (fax), or by email at *mgarrett@fulbright.com*.

Respectfully submitted,



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